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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,765	12/09/2003	Yoshiyuki Kato	H-5092.D2	4279

7590

09/14/2005

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EXAMINER

PARK, ILWOO

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,765

Applicant(s)

KATO ET AL.

Examiner

Ilwoo Park

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/276,440.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/3/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Claims 3-6 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 of U.S. Patent No. 6,539,442 contain every element of claims 3-6 of the instant application and as such anticipate claims 3-6 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis et al., US patent No. 5,805,921 in view of Liu et al., US patent No. 6,304,925.

As to claim 3, Kikinis et al teach a CD-ROM apparatus [col. 3, lines 38-41] having an IDE interface built therein [col. 4, lines 1-3], wherein said drive apparatus connected an IDE interface [ref nos. 15 and 515] a personal computer as a master or a slave. in fact, Kikinis et al further teach the personal computer with the IDE interface selectively selects multiple drives including a hard disk drive and the apparatus drive, which could be a CD-ROM apparatus or a tape drive [col. 2, lines 50-51], connected on an IDE bus in cascade [e.g., fig. 1] and the apparatus drive is selected [col. 5, lines 40-42].

However, Kikinis et al do not disclose said apparatus drive is controlled by an apparatus software driver switching a drive selection bit in the IDE interface, so that said apparatus is selected by switching the drive selection bit only, independently from BIOS of the personal computer. Liu et al teach an apparatus [data archival device (tape drive) 108 in fig. 1] having an IDE interface built therein [col. 6, lines 1-6], wherein a hard disk drive and said drive apparatus connected in cascade to an IDE interface [IDE interface 11 in fig. 2] a personal computer as a master or a slave [col. 8, lines 39-52], said drive is controlled by an apparatus software driver [col. 11, lines 5-14] switching [col. 12, lines

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14-18; col. 13, lines 49-52] a drive selection bit [fig. 5] in the IDE interface, so that said apparatus is selected by switching the drive selection bit only, independently [col. 13, lines 2-10] from BIOS of the personal computer. Therefore, it would have been obvious to one of ordinary skill in the art of IDE interface at the time the invention was made to combine the teachings of Kikinis et al and Liu et al because they both teach a personal computer with an IDE interface selectively selecting multiple drives including a hard disk drive and an apparatus drive [CD-ROM drive could also be a tape drive in Kikinis et al: col. 2, lines 50-51] connected in cascade on the IDE bus and the Liu et al's teaching of a personal computer having an apparatus drive software driver controlling a drive selection bit in the IDE interface, so that said apparatus is selected by switching the drive selection bit only, independently from BIOS of the personal computer would increase speedy operation of both multiple drives [Liu et al: col. 3, lines 32-54; col.9, lines 25-43].

5. As to claim 4, Kikinis et al teach a personal computer comprising:
 - an IDE interface [ref nos. 15 and 515] provided a personal computer,
 - an IDE BUS [ref nos. 17 and 517] connected to said IDE interface of said personal computer, and
 - a CD-ROM apparatus [col. 3, lines 38-41] containing an IDE interface [col. 4, lines 1-3] which can be directly connected [figs. 1-5] to said IDE interface of said personal computer through said IDE BUS,

wherein said CD-ROM apparatus is connected [col. 4, lines 17-22 and figs. 1, 2, and 5] to said interface of said personal computer as a master or a slave, and said CD-ROM apparatus selected.

However, Kikinis et al do not disclose said apparatus drive is controlled by an apparatus software driver switching a drive selection bit in the IDE interface, so that said apparatus is selected by switching the drive selection bit only, independently from BIOS of the personal computer. Liu et al teach an apparatus [data archival device (tape drive) 108 in fig. 1] ~~having an IDE interface built therein~~ [col. 6, lines 1-6], wherein a hard disk drive and said drive apparatus connected in cascade to an IDE interface [IDE interface 11 in fig. 2] a personal computer as a master or a slave [col. 8, lines 39-52], said drive is controlled by an apparatus software driver [col. 11, lines 5-14] switching [col. 12, lines 14-18; col. 13, lines 49-52] a drive selection bit [fig. 5] in the IDE interface, so that said apparatus is selected by switching the drive selection bit only, independently [col. 13, lines 2-10] from BIOS of the personal computer. Therefore, it would have been obvious to one of ordinary skill in the art of IDE interface at the time the invention was made to combine the teachings of Kikinis et al and Liu et al because they both teach a personal computer with an IDE interface selectively selecting multiple drives including a hard disk drive and an apparatus drive [CD-ROM drive could also be a tape drive in Kikinis et al: col. 2, lines 50-51] connected in cascade on the IDE bus and the Liu et al's teaching of a personal computer having an apparatus drive software driver controlling a drive selection bit in the IDE interface, so that said apparatus is selected by switching the drive selection bit only, independently from BIOS of the personal computer would

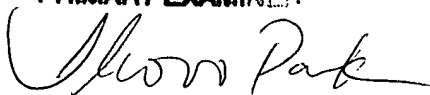
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increase speedy operation of both multiple drives [Liu et al: col. 3, lines 32-54; col.9, lines 25-43].

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ilwoo Park whose telephone number is (571) 272-4155. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ILWOO PARK
PRIMARY EXAMINER



Ilwoo Park

September 9, 2005